



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,423	04/09/2001	Erik K. Voskuil	19946-018	8711

30623 7590 09/21/2004

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY
AND POPEO, P.C.
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER

PHAM, THOMAS K

ART UNIT

PAPER NUMBER

2121

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,423

Applicant(s)

VOSKUIL, ERIK K.

Examiner

Thomas K Pham

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

First Action on the Merits

1. Claims 1-35 of U.S. Application 09/829,423 filed on 4/9/2001 are presented for examination.

Quotations of U.S. Code Title 35

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim Rejections - 35 USC § 102

6. Claims 1-8, 10-17, 19-26 and 29-35 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,301,707 ("Carroll").

Regarding claims 1, 10 and 19

Carroll teaches a system for identifying and configuring an application located at a remote computer, said system comprising: a profile server connected to said remote computer via a network, said profile server including an extension module, and said profile server being adapted for sending said extension module and data to and receiving data from said remote computer (col. 6 lines 17-22, "the installation system 250 ... configuration of computer 2"); and a remote computer connected to said profile server via said network, said remote computer including a remote application adapted for receiving said extension module from said profile server and executing said extension module (col. 6 lines 35-46, "the shipment manager 204 ... for execution by the CPU 155"); said remote application further being adapted for sending data to and receiving data from said profile server (col. 6 lines 47-57, "A network system 210 ... to the target system"); wherein said remote computer includes at least one installed application component and said extension module is adapted for identifying that said application component is installed on said remote computer and for configuring said application according to a predefined application configuration (col. 6 line 58 to col. 7 line 28, "The shipment manager 204 ... by reading the feed file 208").

Regarding claims 2, 11 and 20

Carroll teaches extension module includes a plurality of executable functions and said extension module is adapted for identifying that said application component is installed on said remote

Art Unit: 2121

computer and for configuring said application installed on said remote computer by executing a plurality of said executable functions in a predefined sequence (col. 4 lines 9-17, “The detailed descriptions that follow ... leading to a desired result”).

Regarding claims 3, 12 and 21

Carroll teaches predefined sequence is received from said profile server (col. 6 lines 17-20, “the installation system 250 ... in the target system”).

Regarding claims 4, 13 and 22

Carroll teaches predefined sequence is included with said extension module (col. 6 lines 39-42, “the shipment manager 204 ... of the target system 200”).

Regarding claims 5, 14 and 23

Carroll teaches at least one of said executable functions is adapted searching for a predefined file installed on said remote computer (col. 9 line 1-4, “application programs running ... to the network system 210, 214”) and at least one of said executable functions is adapted for modifying a predefined file installed on said remote computer (col. 9 lines 6-12, “When the installation process ... associated with the PCN”).

Regarding claims 6, 15 and 24

Carroll teaches remote application is a browser application adapted for displaying data received from said profile server (col. 10 lines 59-64, “the target system 200 ... document on the display 120”).

Regarding claims 7, 16 and 25

Carroll teaches extension module is a plug-in module for said browser application (col. 11 lines 20-25, “the carrier manager 216 ... memory area of the target system 200”).

Art Unit: 2121

Regarding claims 8, 17 and 26

Carroll teaches profile server includes command instructions and said profile server is adapted for sending data to said extension module representative of said command instructions which instruct said extension module to search for and modify a predefined file installed on said remote computer (col. 11 lines 58-64, “the installation media 270 ... of the software system”).

Regarding claim 29

Carroll teaches identifying an application located on a remote computer, comprising the steps of: establishing a connection between a profile server and said remote computer (col. 8 line 66 to col. 9 line 1, “To accomplish installation ... the installation system 250”); transferring an extension module to said remote computer (col. 9 lines 1-4, “application programs running ... network system 210, 214”); executing a discovery function of the extension module on said remote computer and generating data representative of the installed [applications and/or] application components and configurations on said remote computer (col. 9 lines 5-12, “A user of the installation ... associated with the PCN”); transferring said data representative of the installed [applications,] application components, and/or configurations to said profile server (col. 9 lines 12-18, “The carrier files selected ... of the target system 200”);

Regarding claim 30

Carroll teaches querying a user of said remote computer to select which installed applications and/or application components said user desires to be configured (col. 10 lines 20-25, “The carrier manager 216 ... integral to the OS 202”); for each installed application and/or application component, analyzing the data representative of the installed application and/or application component to determine the proper configuration for each (col. 9 lines 22-35, “When all PCNs

Art Unit: 2121

have ... is connected to one"); transferring configuration data to the end user computer (col. 9 lines 35-40, "Use of the system ... by the carrier manager 216"); executing a configuration module of said extension module to configure each installed application and/or application component selected by the end user (col. 7 lines 19-28, "PCNs also refer to ... the feed file 208"); generating and transferring data representative of the results of configuration of each application and/or application component (col. 7 lines 62-67, "The supported carriers list ... in a target system 200"); reporting the results of the configuration to the end user; and storing the results of the process (col. 8 lines 54-65, "Generally, before this process ... is then ready for use").

Regarding claim 31

Carroll teaches a method of identifying and configuring an application located on a remote computer, said method comprising the steps of: establishing a connection between a profile server and said remote computer (col. 8 line 66 to col. 9 line 1, "To accomplish installation ... the installation system 250"); transferring an extension module to said remote computer (col. 9 lines 1-4, "application programs running ... network system 210, 214"); executing a discovery function of the extension module on said remote computer and generating data representative of the installed [applications and/or] application components and configurations on said remote computer (col. 9 lines 5-12, "A user of the installation ... associated with the PCN"); for each installed application and/or application component, analyzing the data representative of the installed application and/or application component to determine the proper configuration for each (col. 9 lines 22-35, "When all PCNs have ... is connected to one"); transferring configuration data to the end user computer (col. 9 lines 35-40, "Use of the system ... by the

Art Unit: 2121

carrier manager 216”); executing a configuration module of said extension module to configure each installed application and/or application component selected by the end user (col. 7 lines 19-28, “PCNs also refer to ... the feed file 208”);

Regarding claim 32

Carroll teaches generating and transferring data representative of the results of configuration of each application and/or application component (col. 7 lines 62-67, “The supported carriers list ... in a target system 200”); reporting the results of the configuration to the end user; and storing the results of the process (col. 8 lines 54-65, “Generally, before this process ... is then ready for use”).

Regarding claim 33

Carroll teaches transferring said data representative of the installed [applications,] application components, and/or configurations to said profile server (col. 9 lines 12-18, “The carrier files selected ... of the target system 200”); querying a user of said remote computer to select which installed applications and/or application components said user desires to be configured (col. 10 lines 20-25, “The carrier manager 216 ... integral to the OS 202”);

Regarding claim 34

Carroll teaches an apparatus for identifying an application located on a remote computer comprising: a profile server connected to said remote computer via a network, said profile server including at least one extension module adapted to be received by said remote computer and executed by an application located on said remote computer (col. 6 lines 17-22, “the installation system 250 ... configuration of computer 2”), a database of discovery instructions, adapted to be used by said extension module to identify at least one application located at said remote

Art Unit: 2121

computer (col. 5 lines 56-61, "importing information from a network ... storage devices 171, 172, 173").

Regarding claim 35

Carroll teaches profile server further includes a database of configuration instruction adapted to be used by said extension module to configure at least one application located at said remote computer (col. 6 lines 60-63, "The feed files stores ... by the shipment manager 204").

Claim Rejections - 35 USC § 103

7. Claims 9, 18 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,301,707 ("Carroll").

Regarding claims 9, 18 and 27

Carroll teaches profile server is adapted for sending said command instructions to said extension module but does not specifically teach the instruction is in XML format. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a command instruction in XML format because it would provide for using a web enable language that would be best for transferring data over the internet.

Regarding claim 28

Carroll does not teach the extension module is adapted for prompting a user of said remote computer for authorization to configure said application. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to include at least a secure login when accessing a system with at least an administrator privilege to configure one or more applications.

Art Unit: 2121

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thomas Pham*; whose telephone number is (703) 305-7587 or the new number (571) 272-3689 beginning around mid. October 2004, Monday - Friday from 8:00 AM - 5:00 PM EST or contact Supervisor *Mr. Anthony Knight* at (703) 308-3179 (or 571 272-3687 starting around mid. Oct. 2004).

Any response to this office action should be mailed to: **Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450**. Responses may also be faxed to the **official fax number (703) 872- 9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas Pham
Patent Examiner

TP

September 17, 2004


Anthony Knight
Supervisory Patent Examiner
Group 3600